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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,999	08/14/2001	Peter H. Gien	388022003900	8052
7590	07/17/2006		EXAMINER	
Edward J. Radlo, Esq. (SONNENSCHEIN NATH & ROSENTHAL LLP) 6th Floor 685 Market Street San Francisco, CA 94105			TESLOVICH, TAMARA	
			ART UNIT	PAPER NUMBER
			2137	
DATE MAILED: 07/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/928,999	GIEN ET AL.
	Examiner	Art Unit
	Tamara Teslovich	2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05.02.06 and 06.12.06.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 June 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This action is in response to the Applicant's Remarks and Amendments filed May 2, 2006.

Claims 1 and 13 have been amended.

Claims 18-24 are cancelled.

Claims 1-17 are herein considered.

### ***Response to Amendment***

The Applicant's amendments to the drawings have overcome the Examiner's previous objections and are accepted.

The Applicant's amendments to the specification to add in missing serial numbers have overcome the previous objections and are accepted.

The Examiner withdraws her objections to claim 4 in light of the Applicant's comments and specification.

The Applicant's addition of the term "legal" to claim 1 is not accepted by the Examiner as it introduces new matter not previously claimed or supported by the specification. The Examiner draws the Applicant's attention to 35 U.S.C. 132(a) which states that no amendment shall introduce new matter into the disclosure of the invention. Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

Applicant's arguments filed May 2, 2006 have been fully considered but they are not persuasive.

As per Applicants first argument concerning Brands' alleged failure to disclose a contract or the concept of "legal ownership", the Examiner refers back to the abovementioned rejections concerning the addition of new matter.

As per Applicant's next set of arguments concerning Brands' alleged failure to teach an "only instance of a private key", the Examiner respectfully disagrees. The Examiner would like to point back to page 6 of the Applicant's remarks wherein he notes that both Brands and the Applicant store their private key securely so that it may not be leaked, and may remain 'secret'. In accordance with both the Applicant's invention as well as Brands' it is imperative that the secret key remain secret, and it is for this reason that the key is stored within a secure hardware token. Nowhere in Brands is it suggested that the key would be stored anywhere else, rather throughout the prior art, it is made clear that the key is to be kept within the secure token and nowhere else. The Examiner has taken this to suggest that the instance of the private key located within the secure hardware token is the only existing instance of the key in order to be sure that the key is kept secure and out of the hands of any other individual.

As per Applicant's next set of arguments concerning Brands' alleged failure to teach the step of "a digital certificate for the subscriber", the Examiner respectfully disagrees and draws the Applicant's attention to column 17 line 66

thru column 18 line 6. Within this cited portion, Brands discloses the creation and sending of the digital certificate and digital signature from the user's device (UC) to the RC. It is clear from the cited section above that Brands does in fact disclose the creation and use of a user's digital certificate.

Therefore, based on the above arguments, the Examiner maintains the rejections as set forth in the previous office action and amended below in response to Applicant's amendments.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase "legal ownership" within independent claim 1 is vague and indefinite, failing to find support in the specification. The Examiner is unable to comprehend exactly what a contract establishing "legal ownership" would entail, if a true "legal authority" exists and what that would be, and the difference between simple "ownership" and "legal ownership".

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,668,878 to Stefanus Alfonsus Brands.**

Regarding **claim 1**, Brands teaches a method for facilitating secure hardware token issuance and use, said method comprising the steps of storing an only instance of a private ("secret") key within the hardware token ("tamper resistant computing device"), the hardware token being adapted to prevent the private key from being exported from the hardware token (col.5 lines 13-16), binding the private key to a subscriber with a digital certificate for the subscriber (col.8 lines 56-64; col.10 lines 6-17), creating a contract establishing legal ownership over the physical manifestation of the private key as contained within the hardware token, and the subscriber using the private key to create a digital signature (col.4 lines 23-47; col.10 lines 19-49).

Regarding **claim 2**, Brands teaches wherein the hardware token is issued by a trusted entity (col.11 line 65 thru col.12 line 17; col.15 lines 26-31; col.16 lines 4-14).

Regarding **claim 3**, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by the trusted entity (col.16 lines 4-36).

Regarding **claim 4**, Brands teaches wherein the trusted entity is an issuing participant (col.11 line 65 thru col.12 line 17; col.15 lines 26-31; col.16 lines 4-14).

Regarding **claim 5**, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by a root entity (col.7 lines 55-67 col.8 lines 13-14, 29-38).

Regarding **claim 6**, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by the subscriber (col.7 lines 55-67 col.8 lines 13-14, 29-38).

Regarding **claim 7**, Brands teaches wherein the hardware token is a smartcard (col.8 lines 25-27).

Regarding **claim 8**, Brands teaches wherein the hardware token is a PCMCIA device (col.8 lines 25-27).

Regarding **claim 9**, Brands teaches wherein the private key is an identity private key (col.11 lines 1-6).

Regarding **claim 10**, Brands teaches wherein the hardware token comprises means for monotonically counting each time the private key is used to create a digital signature (col.10 lines 1-5).

Regarding **claim 11**, Brands teaches wherein the hardware token comprises means for permanently storing a PIN/passphrase (col.7 lines 55-67).

Regarding **claim 12**, Brands teaches wherein the subscriber must enter the PIN/passphrase before a digital signature is generated (col.13 lines 45-67).

Regarding **claim 13**, Brands teaches wherein the subscriber must enter the PIN/passphrase each time a digital signature is generated (col.12 line 59 thru col.13 line 14).

Regarding **claim 14**, Brands teaches wherein the digital signature comprises security data (col.9 lines 16-24).

Regarding **claim 15**, Brands teaches wherein the security data is signed to create a security-data cryptogram (col.10 line 31 thru col.11 line 6).

Regarding **claim 16**, Brands teaches wherein the security-data cryptogram is generated using an algorithm different than the one used to create the digital signature (col.10 line 31 thru col.11 line 6).

Regarding **claim 17**, Brands teaches wherein the security data comprises data that is the subject of the digital signature (col.9 lines 16-24; col.9 lines 33-36).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

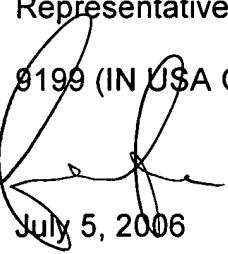
action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service

Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



July 5, 2006

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER